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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.     | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------|------------------|
| 09/901,244  | 07/09/2001  | Gabriel Raviv        | 29888/36772A            | 8384             |
| 4743  | 7590        | 08/09/2005           | EXAMINER                |                  |
| MARSHALL, GERSTEIN & BORUN LLP<br>233 S. WACKER DRIVE, SUITE 6300<br>SEARS TOWER<br>CHICAGO, IL 60606 |             |                      | MARMOR II, CHARLES ALAN |                  |
|   |             |                      | ART UNIT                | PAPER NUMBER     |
|   |             |                      | 3736                    |                  |

DATE MAILED: 08/09/2005

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/901,244

Filing Date: July 09, 2001

Appellant(s): RAVIV ET AL.

**MAILED**

**AUG 4 9 2005**

**Group 3700**

Anthony G. Sitko  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed February 14, 2005 appealing from the Office  
action mailed July 28, 2004

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of the claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

The amendment after final rejection filed on February 14, 2005 and the replacement drawing sheets filed November 2, 2005 have been entered.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 60-72 stand rejected under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 2,487,038 to Baum.
2. Claims 60-72 stand rejected under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 4,540,063 to Ochi et al.
3. Claims 60-65 and 70-72 stand rejected under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 5,113,967 to Killion et al.
4. Claims 60-65 and 70-72 stand rejected under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 4,057,051 to Kerouac in view of U.S. Patent No. 2,487,038 to Baum.
5. Claim 63 stands rejected as indefinite under 35 U.S.C. 112, second paragraph.
6. Claim 70 stands rejected as indefinite under 35 U.S.C. 112, second paragraph.

**(10) Response to Arguments**

Applicant's arguments have been fully considered but they are not persuasive.

1. Applicant contends that Claim 60 is patentable over Baum. Applicant argues that the preamble of claim 60, and therefore all claims which depend from claim 60, while not forming a part of the claimed invention, serves to define the structure of the claimed invention and that MPEP 2111.02 makes clear that terminology in the preamble can serve to limit the structure of the claimed invention.

In response to applicant's arguments, the recitation "for a probe which can be inserted into an ear canal, the probe having an outer surface, a length to be covered by the ear probe tip and a probe end" has been given minimal patentable weight. Not only does this recitation occur in the preamble, but it merely defines the intended use of the probe tip of the present invention. A preamble is generally not accorded any patentable weight where it merely recites the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Applicant has stated that the "ear probe was not intended to be part of the invention" (see at least page 14, lines 7-11). Therefore, the structural limitations of the ear probe tip must be able to stand alone, and the ear probe tip need only be capable of interacting with a given ear probe in the fashion required by the claims.

Baum teaches an ear probe tip including a body portion (11) having a first end and a second end; a passage (20) formed in the body portion including a surface extending from a first opening at the first end to a second opening at the second end; an outer surface of the body portion; and a plurality of annular flanges (41,42,43) on the outer surface. Each of the plurality of annular flanges has a substantially circular shape and a diameter, where the diameter of

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adjacent flanges decreases in size from the first end toward the second end (see Fig. 1). The passage has a cylindrical shape. The body portion has a frusto-conical shape (see Fig. 1). The plurality of annular flanges are disposed proximate to the middle portion of the body portion, and each of the plurality of flanges is disposed substantially perpendicular to the body portion. The first opening includes a chamfer (see Fig. 4). The passage has an increased diameter portion (22) adjacent the first opening and an incrementally decreasing diameter from the first end toward the second end. A ring (21) is formed on the outer surface adjacent the first end and the outer surface has an incrementally decreasing diameter from the first end toward the second end (31,32,33). The first end includes a surface configured to engage a base portion of the probe. In view of the foregoing, the ear probe tip of Baum meets all of the physical structural characteristics of the claimed ear probe tip when considered as a stand alone device.

The Examiner notes that the claims of the instant application merely define the structure of the ear probe to have an outer surface, a length and a probe end. Nearly every type of ear probe that exists in the medical arts would include these structural elements. The claims fail to further define any other structural characteristics of the ear probe that is used with the claimed ear probe tip, such as the shape or dimensions thereof. Moreover, the claims also fail to define what type of ear probe is intended to be used with the claimed ear probe tip, such as a hearing test probe, a probe for an IR thermometer, or an otoscope. Given that Applicant states that the "ear probe was not intended to be part of the invention" and the myriad of known types of ear probes that exist in the medical arts, it is a near certainty that a ear probe exists that is capable of being used with the ear probe tip of Baum in a fashion such that the body portion of the Baum probe tip will have the same length as the probe tip to be covered, a passage of the Baum probe

tip will be substantially in contact with the probe along the length to be covered, and the second opening of the Baum probe tip will be proximate to the probe end. The Examiner respectfully submits that the ear probe tip of Baum is not limited to use with the ear probe illustrated in the Figures. Therefore, the ear probe tip of Baum would be capable of performing the intended use of the claimed ear probe tip of the present invention.

Regarding Applicant's repeated arguments that ear probe tip of the instant application is configured such that the tip does not require an acoustic channel, it is noted that the features upon which applicant relies (i.e., the tip does not require an acoustic channel) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

2. Applicant contends that Claim 60 is patentable over Ochi et al. Applicant argues that the preamble of claim 60, and therefore all claims which depend from claim 60, while not forming a part of the claimed invention, serves to define the structure of the claimed invention and that MPEP 2111.02 makes clear that terminology in the preamble can serve to limit the structure of the claimed invention.

In response to applicant's arguments, the recitation "for a probe which can be inserted into an ear canal, the probe having an outer surface, a length to be covered by the ear probe tip and a probe end" has been given minimal patentable weight. Not only does this recitation occur in the preamble, but it merely defines the intended use of the probe tip of the present invention. A preamble is generally not accorded any patentable weight where it merely recites the intended use of a structure, and where the body of the claim does not depend on the preamble for

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completeness but, instead, the structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Applicant has stated that the “ear probe was not intended to be part of the invention” (see at least page 14, lines 7-11 of the Appeal Brief). Therefore, the structural limitations of the ear probe tip must be able to stand alone, and the ear probe tip need only be capable of interacting with a given ear probe in the fashion required by the claims.

Ochi et al. teaches an ear probe tip (12) including a body portion (see Fig. 5) having a first end and a second end; a passage (30,50,54) formed in the body portion including a surface extending from a first opening at the first end to a second opening at the second end; an outer surface of the body portion; and a plurality of annular flanges (56,58) on the outer surface. Each of the plurality of annular flanges has a substantially circular shape and a diameter, where the diameter of adjacent flanges decreases in size from the first end toward the second end (see Fig. 5). The passage has a cylindrical shape. The body portion has a frusto-conical shape (see Fig. 5). The plurality of annular flanges are disposed proximate to the middle portion of the body portion, and each of the plurality of flanges is disposed substantially perpendicular to the body portion. The first opening includes a chamfer. The passage has an increased diameter portion adjacent the first opening and an incrementally decreasing diameter from the first end toward the second end. A ring (60) is formed on the outer surface adjacent the first end and the outer surface has an incrementally decreasing diameter from the first end toward the second end. The first end includes a surface (62) configured to engage a base portion of the probe. In view of the foregoing, the ear probe tip of Ochi et al meets all of the physical structural characteristics of the claimed ear probe tip when considered as a stand alone device.



The Examiner notes that the claims of the instant application merely define the structure of the ear probe to have an outer surface, a length and a probe end. Nearly every type of ear probe that exists in the medical arts would include these structural elements. The claims fail to further define any other structural characteristics of the ear probe that is used with the claimed ear probe tip, such as the shape or dimensions thereof. Moreover, the claims also fail to define what type of ear probe is intended to be used with the claimed ear probe tip, such as a hearing test probe, a probe for an IR thermometer, or an otoscope. Given that Applicant states that the “ear probe was not intended to be part of the invention” and the myriad of known types of ear probes that exist in the medical arts, it is a near certainty that an ear probe exists that is capable of being used with the ear probe tip of Ochi et al in a fashion such that the body portion of the “Ochi” probe tip will have the same length as the probe tip to be covered, a passage of the “Ochi” probe tip will be substantially in contact with the probe along the length to be covered, and the second opening of the “Ochi” probe tip will be proximate to the probe end. The Examiner respectfully submits that the ear probe tip of Ochi et al is not limited to use with the ear probe illustrated in the Figures. Therefore, the ear probe tip of Ochi et al would be capable of performing the intended use of the claimed ear probe tip of the present invention.

3. Applicant contends that Claim 60 is patentable over Killion et al. Applicant argues that the preamble of claim 60, and therefore all claims which depend from claim 60, while not forming a part of the claimed invention, serves to define the structure of the claimed invention and that MPEP 2111.02 makes clear that terminology in the preamble can serve to limit the structure of the claimed invention.

In response to applicant's arguments, the recitation "for a probe which can be inserted into an ear canal, the probe having an outer surface, a length to be covered by the ear probe tip and a probe end" has been given minimal patentable weight. Not only does this recitation occur in the preamble, but it merely defines the intended use of the probe tip of the present invention. A preamble is generally not accorded any patentable weight where it merely recites the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Applicant has stated that the "ear probe was not intended to be part of the invention" (see at least page 14, lines 7-11 of the Appeal Brief). Therefore, the structural limitations of the ear probe tip must be able to stand alone, and the ear probe tip need only be capable of interacting with a given ear probe in the fashion required by the claims.

Killion et al. teaches an ear probe tip (30) including a body portion (see Fig. 4A) having a first end and a second end; a passage (33) formed in the body portion including a surface extending from a first opening at the first end to a second opening at the second end; an outer surface of the body portion; and a plurality of annular flanges (34A-34C) on the outer surface. Each of the plurality of annular flanges has a substantially circular shape and a diameter, where the diameter of adjacent flanges decreases in size from the first end toward the second end (see Fig. 4A). The passage has a cylindrical shape. The body portion has a frusto-conical shape (see Fig. 4A). The plurality of annular flanges are disposed proximate to the middle portion of the body portion, and each of the plurality of flanges is disposed substantially perpendicular to the body portion. The outer surface has an incrementally decreasing diameter from the first end

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toward the second end. The first end includes a surface configured to engage a base portion of the probe. In view of the foregoing, the ear probe tip of Killion et al meets all of the physical structural characteristics of the claimed ear probe tip when considered as a stand alone device.

The Examiner notes that the claims of the instant application merely define the structure of the ear probe to have an outer surface, a length and a probe end. Nearly every type of ear probe that exists in the medical arts would include these structural elements. The claims fail to further define any other structural characteristics of the ear probe that is used with the claimed ear probe tip, such as the shape or dimensions thereof. Moreover, the claims also fail to define what type of ear probe is intended to be used with the claimed ear probe tip, such as a hearing test probe, a probe for an IR thermometer, or an otoscope. Given that Applicant states that the “ear probe was not intended to be part of the invention” and the myriad of known types of ear probes that exist in the medical arts, it is a near certainty that an ear probe exists that is capable of being used with the ear probe tip of Killion et al in a fashion such that the body portion of the “Killion” probe tip will have the same length as the probe tip to be covered, a passage of the “Killion” probe tip will be substantially in contact with the probe along the length to be covered, and the second opening of the “Killion” probe tip will be proximate to the probe end. The Examiner respectfully submits that the ear probe tip of Killion et al is not limited to use with the ear probe illustrated in the Figures. Therefore, the ear probe tip of Killion et al would be capable of performing the intended use of the claimed ear probe tip of the present invention.

Regarding Applicant’s arguments that ear probe tip of Killion et al. includes the sound passage that the instant application is configured to eliminate, it is noted that the features upon which applicant relies (i.e., the absence of a sound passage or an acoustic channel) are not recited

in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

4. Applicant contends that Claim 60 is patentable over Kerouac in view of Baum. Applicant contends that there is no motivation to combine Kerouac and Baum. Applicant further argues that if the ear insert of Baum were used with the ear probe of Kerouac, the probe tip of Kerouac would not be disposed proximate the second opening of the ear insert of Baum. These arguments are not persuasive.

Regarding Applicant's argument that there is no motivation to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both references teach the use of probe covers that are intended to protect the probe tip and form a seal with the ear canal walls, while Baum provides motivation to provide a probe tip cover with a plurality of annular flanges so that the probe tip cover may be used with ears of a variety of sizes and form a good acoustic seal between the tip and the ear canal (see Baum, column 1, line 45 - column 2, line 9 and column 4, lines 4-17).

Regarding Applicant argument that if the ear insert of Baum were used with the ear probe of Kerouac, the probe tip of Kerouac would not be disposed proximate the second opening of the ear insert of Baum. The Examiner respectfully submits that the rejection set forth in the

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Office Action of July 28, 2004 did not suggest using the ear tip of Baum with the ear probe of Kerouac. Instead the Examiner stated that it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to *provide the outer surface of an ear probe tip similar to that of Kerouac with a plurality of annular flanges in view of the teachings of Baum* in order to automatically provide an acoustic seal with the outer ear cavity that prevents propagation of sound through the space of the ear cavity surrounding the exterior of the ear probe tip, where the probe tip of Kerouac would remain disposed proximate the second opening of the ear insert of Kerouac as illustrated in Figures 2 and 8 of Kerouac.

5. Applicant contends that Claim 63 is definite with respect to 35 USC 112.

Applicant contends that the language is clear and that at least one of the plurality of flanges is circular. The Examiner respectfully disagrees. Claim 60 recites that "a plurality of annular flanges" are disposed on the outer surface at line 13. Claim 63 recites that "*the annular flange* comprises a substantially circular shape." The inconsistency in the claim language renders the claim indefinite. More specifically, the language of claim 63 is unclear in that one is left to question whether only one of the plurality of the flanges has a substantially circular shape, each of the plurality of flanges have a substantially circular shape, or which one of the plurality of flanges has a substantially circular shape.

6. Applicant contends that Claim 70 is definite with respect to 35 USC 112.

Applicant contends that the language is clear that Applicants intend to claim an ear probe tip. The Examiner respectfully disagrees. Claim 60 provides no positive recitation of the probe, implying that Applicant is attempting to merely claim the subcombination of the ear probe tip. However, claim 70 uses claim language that positively recites a probe and a probe end, and a

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relationship between the probe and the ear probe tip that indicates that Applicant is claiming the combination of an ear probe positively disposed within the ear probe tip.

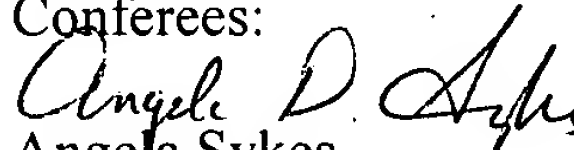
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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